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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 59013-331629 |
| I HEREBY CERTIFY THAT THIS PAPER (ALONG WITH ANY REFERRED TO AS BEING ATTACHED OR ENCLOSED) IS BEING TRANSMITTED TO THE COMMISSIONER FOR PATENTS, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450 ON DECEMBER 8, 2006 VIA THE USPTO-EFS-WEB FILING SYSTEM _____ /Jennifer Barnes/ Jennifer Barnes | | Application Number 10/809,962 |
| | | Filed 03/26/2004 |
| | | First Named Inventor Clifton A. Alferness |
| | | Art Unit 3735 |
| | | Examiner GILBERT, SAMUEL G. |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 52,079
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Brian W. Oberst reg. no. 52079/

Signature

Brian W. Oberst

Typed or printed name

612/766-7174

Telephone number

December 8, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*

☒ *Total of 4 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL REQUEST FOR REVIEW

The Applicant appeals the rejection of claims 18, 19, 22, 23, 25, 26, 28, 34, and 35 as set forth in the final Office Action mailed September 8, 2006. In that Office Action, claims 18, 19, 22, 23, 28, and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,839,842 (“Wanat”). In addition, claims 18, 19, 22, 23, 26, 28, 34, and 35 were rejected under 35 U.S.C § 102(b) as being anticipated by U.S. Patent 1,682,119 (“Field”). Still additionally, claims 18, 19, 22, 23, 28, and 34 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,551,543 (“Mercer”). Finally, claims 18, 19, 22, 23, 25, 28, 34, and 35 were rejected under 35 U.S.C § 102(b) as being anticipated by U.S. Patent 2,376,452 (“Mehler”). As explained below, the Applicant respectfully submits that the foregoing rejections are clearly deficient.

The rejected claims recite a device for treating a disease of the heart, and include several structural features relating to the configuration of the claimed device for placement on a heart and for constraining circumferential expansion of the heart. In particular, independent claim 18, from which all other rejected claims depend, recites that the device comprises a jacket dimensioned to be placed on the heart, surrounding at least a lower portion of the heart, and sized and shaped to snugly conform to an external geometry of the heart. Claim 18 further recites that the jacket is constructed from a biocompatible material selected to exhibit an amount of expansion in response to a force applied to said material by a heart in a first direction greater than an amount of expansion in response to said force applied to said material by a heart in a second direction. Thus, the device exhibits differential expansion characteristics depending on the direction of application of force on the jacket by the heart. As disclosed in the specification, for example, at page 14, lines 8-29, the claimed device provides substantial advantages, including constraining circumferential expansion of the heart while not impeding other motion of the heart.

In contrast, however, the prior art patents relied upon in the Office Action have nothing to do with a device for treating a disease of the heart. Rather, the cited prior art patents disclose, in turn: (1) a “cleansing kit” including an open cell mesh bag enclosing a sponge and a toilet bar (the Wanat Patent); (2) a method for extruding a plastic net in a sheet or tubular form (the Mercer patent); (3) a cleaning device including a soap contained

in an “envelope or container” made from a soft metal mesh (including aluminum, copper, and “German Silver,” a copper alloy) having “scraping edges” for scraping the surface to be cleaned (the Field patent); and (4) “tubular netting” primarily for the lowering of dynamite or other explosives in drill holes (the Mehler patent). Clearly, none of the cited references have anything to do with a device for treating a disease of the heart. As such, none of the cited references disclose a jacket sized and shaped to snugly conform to an external geometry of the heart, much less do any disclose such a device having differential expansion characteristics depending on the direction of force applied to the device by the heart. Accordingly, the cited references cannot anticipate the claims currently under rejection.

In conclusion, for at least the foregoing reasons, the Applicant respectfully submits that the Office Action’s rejections of claims 18, 19, 22, 23, 25, 26, 28, 34, and 35 over the Wanat, Mercer, Field, and Mehler patents, collectively, are clearly deficient. Review of the foregoing arguments and allowance of claims 18, 19, 22, 23, 25, 26, 28, 34, and 35 is respectfully requested.